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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,256	07/03/2003	Gerhard Reichert	1663-AI	4893
7590 Fred H. Zollinger III P.O. Box 2368 North Canton, OH 44720			EXAMINER AMIRI, NAHID	
			ART UNIT 3679	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/10/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/613,256

Applicant(s)

REICHERT, GERHARD

Examiner

Nahid Amiri

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 62-75,78-82 and 84-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 62-75,78-82 and 84-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 February 2002 has been entered. Claims 1-61, 76, 77, and 83 are canceled. Claims 62-75, 78-82, and 84-93 are pending

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 70-75, 78-82, and 84 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in original specification for "a permeable foamed material" of claim 70, line 10; and "a permeable resilient foam body" of claim 78, line 7. In particular, while the specification states that the body is preferably fabricated from a flexible foam material and that such material may be "any of those foams known to those skilled in the art of foam spacers", e.g., note page 10, lines 2-4, nowhere is it stated that such foam material is "permeable". The inclusion of this limitation constitutes new matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 62-75, 78-82, and 84-93 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,345,743 Baier in view of US Patent No. 5,732,517 Milikovsky.**

With respect to claims 62-75, 78-82, and 84-93, Baier discloses a simulated divided lite insulating glazing unit (Fig. 4) comprising first and second spaced glass panes (12, 14) spaced apart by a perimeter spacer (12), the first and second glass panes (12, 14) and spacer (12) defining a gap, a resilient foam internal muntin bar (22) disposed inside the gap which inherently is capable of being rolled into a roll for storage and shipping and then unrolled for application to the glass; the internal muntin bar (22) dividing the gap into separate portions to provide a divided-lite appearance to the glazing unit; the internal muntin bar (22) having a body having a Longitudinal direction, the body having opposed base walls (24) separated by the height of the body; one of the base walls (24) having an adhesive (34) that connects the base wall (24) to an inner surface of one of the glass panes (14); the base wall having the adhesive (34) defining a body width the body being formed from a body material; and wherein (column 2, lines 60-64) that the body of muntin bar (22) is fabricated from a foam polymer and the foam includes a desiccant. Baier does not disclose the body defining at least one insulating cavity. Milikovsky teaches a window unit (Fig. 2) having glass panes and a spacing elements (3) between glass panes (2 and 4); the spacing elements (3) defining a body (B), the body (B) defining a plurality of insulating cavities (C); wherein the cross section of body material (B) being larger than the cross sectional area of the insulating cavities (C); wherein the body (B) defining a longitudinal direction; and each of the insulating cavity (C) extending continuous in the longitudinal direction; the cavities (C) are spaced apart from one another; and wherein the cavity (C) has a

Art Unit: 3679

width, the space between the cavities (C) being equal to or greater than the width of either cavity. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the muntin bar of Baier with a plurality of insulating cavities as taught by Milikovsky for any of the reasons known in the art. For example, increase the resiliency of the body and/or reduce the effectiveness of the thermal bridge resulting from the muntin bars contacting both sheets of glass.

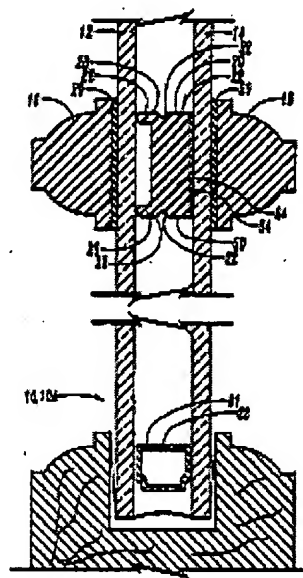
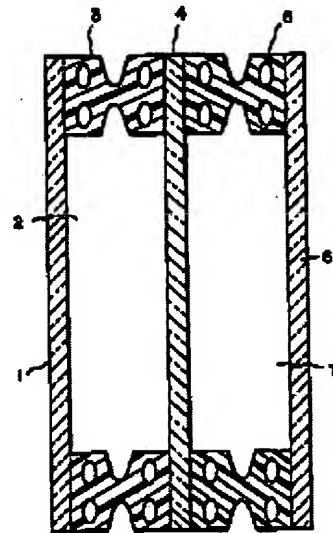


Fig. 4

FIG. 1  
STATE OF THE ART

### *Response to Arguments*

Applicant's arguments filed 22 February 2007 have been fully considered but they are not persuasive.

As to claims 62-68, 70-75, 78-82 and 84-93:

Applicant argues that the muntin bar material of the instant invention is a permeable material, while the material of Baier and Milikovsky is fabricated from a non-permeable material. With respect to this argument, the examiner can find no support in the original specification for "permeable material", and therefore this argument is of little consequence. Moreover, given the lack of any supporting disclosure, the inclusion of this feature constitutes

new matter. In view of the lack of support in the original disclosure and that this feature constitutes new matter, the argument has not been considered further.

Applicant next argues that because a restriction was previously required in this application between claims drawn a muntin bar and claims drawn to a spacer, then this means that no teaching involving features found in a spacer may be applied to a muntin bar because the two elements are patentably distinct. This argument is not persuasive. Specifically, it should be noted that restriction practice pertains to the claims of any one application wherein two or more independent and distinct inventions are claimed in the application. "Restriction" is the practice of requiring applicant to elect a single one of these inventions. Further, restriction may be properly required when the claims of an application define inventions, which are able to support separate patents. A restriction between two such claimed inventions in a single application neither implies nor results in the entire body of prior art references for the non-elected invention being disqualified from consideration when considering the patentability of the elected invention. Accordingly, the fact that there was a restriction in this application is of little consequence and has no bearing on the propriety of the combination of references relied upon to reject claims drawn to the elected invention.

Applicant argues that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. Therefore, the prima facie case of obviousness has not been established.

Examiner disagrees. Test of obviousness is what combined teachings would have fairly suggested to one of ordinary skill in the art, *In re Keller*, 208 USPQ 871 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skill in the art would reasonably be expected to draw therefrom, *In re Preda*, 159 USPQ 342 (CCPA 1968). Further, one is to presume skill, not a lack thereof, on the part of one of ordinary skill in the art, *In re Sovish*, 226 USPQ 771 (CAFC 1985). Further, it should also be noted that there is no requirement for motivation be explicitly found in the references themselves, *In re Keller*, supra, and an examiner may find motivation in the nature of the problem to be solved. Nevertheless, Milikovsky clearly

Art Unit: 3679

teaches use of cavities in spacing elements and the purpose of such cavities is well known to those versed in the art (e.g., reduce effectiveness of thermal bridge).

It is this teaching that is being applied to the muntin bar spacing elements of Baier and this teaching is being applied for the same reasoning known in the art to those of ordinary skill. Whether the particular body is a “muntin bar” or a “spacer” is not seen to be of any difference to the reasoning. Section 103 makes clear that applicant is not entitled to a patent when the differences between the claimed invention and the prior art are obvious.

Further, a prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art, *In re Rinehart* 189 USPQ 143 (CCPA 1976). See also *In re Lalu*, 223 USPQ 1257 (CAFC 1984) and *In re Fine*, 5 USPQ2d 1596 (CAFC 1988).

Further, with respect to Milikovsky, applicant argues that since there is no discussion of what the illustrated feature is, it is improper for the examiner to assume that the feature represents cavities. This is not persuasive. In particular, it is first noted that the illustration of Milikovsky is the same as that used by applicant. Accordingly, how is it that the illustration represents “cavities” when used by applicant, but the same illustration in a prior art reference does not represent “cavities”?

Second, Milikovsky clearly identifies this feature as something that was part of the “state of the art” at least as of 1996 when the application was filed. Being that this feature was part of the state of the art” years before applicant’s instant invention, it certainly is not unreasonable to expect that those of ordinary skill in the art would know what the feature is and why such feature would be present. Applicant makes the allegation that “(n)othing in Milikovsky discloses or teaches the use of cavities in the body of the spacer”, e.g., see page 9. No basis for this statement is set forth and the figures of Milikovsky indicate otherwise since cavities are shown in the body of the spacers. Nevertheless, applicant appears to be seeking to present a position that questions the accuracy of the examiner’s stated interpretation of the factual technical information of the “state of the art” acknowledged by Milikovsky. Accordingly, in accordance with 37 CFR 1.105(a)(1)(viii), applicant is required to submit information known to him concerning what the

Art Unit: 3679


state of the art was and what the illustrated features (identified as cavities by the examiner) are, if not in fact cavities.

With respect to the previous rejection of claims 69, 77 and 84-93 based on Hood as a secondary reference, this rejection has been withdrawn in view of the fact that Baier disclose that the body may include a desiccant and thus Hood is not necessary to the rejection of these claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nahid Amiri whose telephone number is (571) 272-8113. The examiner can normally be reached on 8:30-5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nahid Amiri  
Examiner  
Art Unit 3679  
March 6, 2007



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TECHNOLOGY CENTER 3600